

REMARKS

Claims 19 to 26 are added, therefore claims 10 to 14, 16 and 19 to 26 are now pending in the present application. Applicant hereby respectfully requests further examination and reconsideration of the application based on the following.

Claims 10-14 and 16 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,000,115 ("Lewis"). The rejection should be withdrawn for at least the following reasons.

To reject a claim under 35 U.S.C. § 102(e), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Office Action may be relying on the inherent disclosure doctrine, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Claim 10, as presented is to a "device for programming a controller, comprising: a portable, copy-protected plug-in memory unit for storing software, wherein the copy-protected plug-in memory unit is configured to transport controller software in an encrypted form from a hardware device to the controller."

The Lewis reference does not identically disclose (nor suggest) a device for programming a controller, as provided for in the context of the presently claimed subject matter. Even if the smart chip referred to by Lewis may communicate data with a controller, the smart chip is not used for programming the controller, as provided for in the context of the presently claimed subject matter. In col. 8, l. 13 of Lewis cited by the Examiner, it is clearly stated that the “control program” refers to a program to control the smart chip, and therefore a device for programming a controller is not disclosed in the cited section.

Still further, Lewis does not identically disclose (nor suggest) any device having a *portable, copy-protected plug-in memory unit for storing software*, as provided for in the context of the presently claimed subject matter. The smart chip referred to by Lewis is not a *portable, copy-protected plug-in memory unit for storing software*. Accordingly, no device referred to by Lewis can possibly be considered to be a *portable, copy-protected plug-in memory unit for storing software*, as provided for in the context of the presently claimed subject matter. In col. 2, l. 30-35 of Lewis cited by the Examiner, there is absolutely no suggestion of the described smart chip to be copy-protected plug-in memory unit.

Also, Lewis does not identically disclose (nor suggest) the feature in which *the copy-protected plug-in memory unit is configured to transport controller software in an encrypted form from a hardware device to the controller*. The Lewis reference does not even refer to transporting controller software. Even if Lewis may refer to software components of a digital device that uses a smart chip to identify or authenticate an object and even if Lewis may refer to smart chips that communicate data with a controller, it does not identically disclose (nor suggest) any copy-protected plug-in memory unit is configured to transport controller software in an encrypted form from a hardware device to the controller. In col. 5, l. 48-51 of Lewis cited by the Examiner, as well as in the more detailed description in col. 10, l. 57-61 of Lewis, it is clearly described that the “major software components” are part of the digital device (“within memory 212 of Fig. 2A”), not part of the smart chip, which means no software transport by the smart chip is disclosed in Lewis.

Accordingly, claim 10, as presented, is allowable, as are its dependent claims. Claim 14, as presented, includes features like those of claim 10, as presented, and is therefore

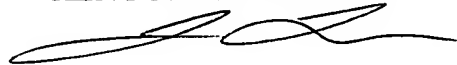
allowable for essentially the same reasons, as are its dependent claims. New claims 19 to 26 do not add any new matter and are supported by the present application, including the specification. Claims 19 to 24 depend from claim 14, as presented, and are therefore allowable for the same reasons as those presented in connection with claim 14. Claims 25 and 26 depend from claim 10, as presented, and are therefore allowable for the same reasons as those presented in connection with claim 10. Accordingly, claims 10 to 14, 16 and 19 to 26 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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